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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,353	03/26/2001	Philip S. Siegel	067439-0111	4525
5073	7590	07/27/2007	EXAMINER	
BAKER BOTTS L.L.P.			SHAAWAT, MUSSA A	
2001 ROSS AVENUE			ART UNIT	
SUITE 600			PAPER NUMBER	
DALLAS, TX 75201-2980			3627	
			NOTIFICATION DATE	DELIVERY MODE
			07/27/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mike.furr@bakerbotts.com  
ptomail1@bakerbotts.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/817,353	<b>Applicant(s)</b> SIEGEL, PHILIP S.	
	<b>Examiner</b> Mussa A. Shaawat	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 10-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 35-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Arguments***

1. This action is in response to amendment filed on April 13, 2007. Claims 1 and 8 have been amended. Claim 46 has been newly added. Claims 10-34 have been previously withdrawn. Claims 1-9 and 35-46 are pending examination.
2. The 35 USC 112 2<sup>nd</sup> paragraph rejection has been withdrawn due to the amendment to claim 1.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7,9,35-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Haseltine.

Haseltine discloses a method for processing the local return of remotely purchased merchandise on the WWW (see Par. # 0025): more specifically, it discloses

1. the customer is identified by the packing slip which he/she bears and thus is automatically associated with the purchased item;
2. transaction history is linked to the bar code packing slip which is gathered when the bar code is read, one of the items of the transaction history which is gathered is statement of the return policy of the e-tailer see, par. 28;

3. regarding the distinction of the step of displaying to a customer, the associate in Haselktine is read as the agent of the customer which inherently is the alter ego of the customer. Also, Inherent to any position in a retail establishment is to allow an employee the use the services of the employer as a benefit of working of a given employer and thus the use could be the customer.

4. the transaction history is displayed on the screen of the computer to which the bar code reader is attached. According to paragraph 28 lines 7 and 8, the product is listed with other information about the transaction and thus answers the "listing" language of claim 1.

5. the item of merchandise selected by the user for return is the one which bears the bar code generated by the e-tailer, and thus is listed within the listing in the transaction history discussed in paragraph 28 lines 7 and 8 of Haseltine. The consumer through its agent 42 is read as a causing a selection to be received by the association server 30 or bureau 44, the selection is read as the item, see, e.g. paragraph [0040], the selection of POKEMAN of the one e-tailer rather than the other e-tailer and the subsequent transmission of the selected one of the POKEMAN devices for return. Because the selection is inputted into a computer, it is read as an "electronic selection".

6. once the server 30 receives the packing-slip information, it initiates by sending instructions for the return, the returns process.

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Re claims 2,3,35,36: retrieving a user preference profile for the consumer is read as - the record on the retailer's site- because somewhere in that record is information which has some preference e.g. which credit card chosen to use versus cash (see par. 0037 for options for refunds).

Re Claim 4: notifying the retailer of the merchandise to be returned (retailer is notified via the associate 42).

Re claim 5: see par.0028 which discloses information yielded by the swiping of slip 26 which includes information on both buyer and seller, retailer return policy and shipper, buyer etc.

RE claim 6 : slip 26 is read as the return shipping label because using it effects the item's return.

Re claim 7: see par. 0039 "such and such shipper" is notified of shipping request for return.

Re claim 9: see par. 0025 for Internet communication.

RE claim 37: the scanning process which identifies the user is read as the log in process.

Re claim 38: once the bar code is scanned the information is provided in real time.

Re claim 39: the bar code is scanned at the discretion of the owner which is periodic relative to his/her buying patterns.

Re claim 40: the seller in Haseltine is an e-tailer.

Re claim 41: the data in the bar code is read as the identifier.

Re claim 42: the fulfillment process at the point of return place includes an authorization see paragraph 0035.

Re claim 43: instructions are read as the rule see paragraph 0035.

Re claim 44: see col. 0026 cookies vs. boxes determination.

RE claim 45: see label 26.

RE: claim 46, the limitations of claim 46 are similar to the limitations of claim 1, therefore it is rejected based on the same rationale.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9,35-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haseltine in view of Dodd.

Haseltine discloses a method for processing the local return of remotely purchased merchandise on the WWW (see Par. # 0025): more specifically, it discloses

1. the customer is identified by the packing slip which he/she bears and thus is automatically associated with the purchased item;

2. transaction history is linked to the bar code packing slip which is gathered when the bar code is read, one of the items of the transaction history which is gathered is statement of the return policy of the e-tailer see, par. 28;

3. the transaction history is displayed on the screen of the computer to which the bar code reader is attached. According to paragraph 28 lines 7 and 8, the product is listed with other information about the transaction and thus answers the "listing" language of claim 1.

4. the item of merchandise selected by the user for return is the one which bears the bar code generated by the e-tailer, and thus is listed within the listing in the transaction history discussed in paragraph 28 lines 7 and 8 of Haseltine. The consumer through its agent 42 is read as a causing a selection to be received by the association

server 30 or bureau 44, the selection is read as the item, see, e.g. paragraph [0040], the selection of POKEMAN of the one e-tailer rather than the other e-tailer and the subsequent transmission of the selected one of the POKEMAN devices for return. Because the selection is inputted into a computer, it is read as an "electronic selection".

5. once the server 30 receives the packing-slip information, it initiates by sending instructions for the return, the returns process.

Regarding the distinction of the step of displaying to a customer, the associate in Haseltine is read as the agent of the customer. Inherent to any position in a retail establishment is to allow an employee the use the services of the employer as a benefit of working of a given employer and thus the user could be the customer. Notwithstanding, Haseltine discloses the context of the user being the point of return associate 42 rather than the customer. However, Dodd does disclose a user as the customer and thus displays return information to the user and causes him to select a return process see, col. 98 lines 42 et seq. displayed to him for selection. It would be obvious to modify the method of Haseltine to include the user driven self return process of Dodd and to provide a selection step, the motivation being the ability to return a product without the need of going to a third party and the ability to allow a user to choose the mode of return e.g. return exchange etc.

Re claim 8: Haseltine disclose the problem with returns in that the customer and client may be separated by the entire breadth of the country making shipping for small products e.g. cookies (paragraph 0026) non cost effective. Thus it would be an obvious



choice to try to sell the product for the best possible price so as not to incur a total loss and the old and notorious way of effecting this is the use of an auction.

Re claims 2-7, 9, 35-46 see above analysis.

### ***Response to Arguments***

7. Applicant's arguments have been fully considered but they are not persuasive. In particular applicant argues A) That the combination of Haseltine in view of Dodd is improper; B) Haseltine does not teach receiving an electronic selection, generated by the consumer; C) applicant is arguing that Haseltine does not suggest that "it would have been an obvious choice to try to sell the product for the best possible price so as not to incur a total loss and the old and notorious way of effecting this is the use of an auction".

In response to applicant's argument that there is no suggestion to combine the references A), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, It would have been extremely advantageous to incorporate the teachings of Dodd into the disclosure of Haseltine for the purpose stated in the last action dated 01/22/2007, the motivation being the ability to return a product without the need of going to a third party and the ability to allow a user to choose the mode of return e.g. return exchange. Therefore, in

view of the above evidence, Haseltine in view of Dodd, still meets the scope of the limitations as currently claimed.

In response to B) Examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. The item of merchandise selected by the user for return is the one which bears the bar code generated by the e-tailer, and thus is listed within the listing in the transaction history discussed in paragraph 28 lines 7 and 8 of Haseltine. The consumer through its agent 42 is read as causing a selection to be received by the association server 30 or bureau 44, the selection is read as the item, see, e.g. paragraph [0040], the selection of POKEMAN of the one e-tailer rather than the other e-tailer and the subsequent transmission of the selected one of the POKEMAN devices for return. Because the selection is inputted into a computer, it is read as an "electronic selection". Therefore Haseltine still meets the scope of the limitation as currently claimed .

In response to applicant's argument that there is no suggestion to combine the references C), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Haseltine disclose's the return of a merchandise or an item, however he does not expressly teach disposing or reselling the returned item by way of auction, however it would be an

obvious choice to try to dispose or resell the item for best possible price so as not to incur a total loss and the old and notorious way of effecting this, is the use of an auction. Therefore Haseltine in view of obviousness, still meets the scope of the limitation as currently claimed.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

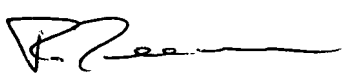
***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mussa A. Shaawat whose telephone number is 571-272-2945. The examiner can normally be reached on Mon-Fri (8am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mussa Shaawat  
Patent Examiner  
July 21, 2007

 7/22/07  
F. RYAN ZEENDER  
SUPERVISORY PATENT EXAMINER